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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,967	01/18/2006	Stephen Cowan	2471.0010000	5392
26111 7590 10/08/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
GARNER, WERNER G				
ART UNIT		PAPER NUMBER		
3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,967

Applicant(s)

COWAN ET AL.

Examiner

WERNER GARNER

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 25 and 28-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18, 25, 28-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 6/9/2006 and 1/17/2007
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. According to claim 4, the "prize value" is determined using "the current prize value" and "the current prior prize value" without clearly identifying what the applicant means within

the claim or the specification. Since applicants make a point of differentiating the two, the examiner interprets "the current prize value" as being the prize value at the end of the progressive cycle, whereas "the current prior prize value" is interpreted as meaning the prize value of the preceding cycle. Using the examiner's definitions, the value of the prize value for the second half of the determination (i.e., when prize value is selected from between "the current prior prize value and the lower prize value") will tend towards the lower limit. Applicants' specification, however, describes selecting a value that lies between the current prize value and the lower prize value (Specification, page 11, lines 11-17).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See discussion above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-3, 5, 7-18, 25, 28-32, 34, and 38** are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen, US 6,110,043 (hereinafter Olsen).

Regarding **Claim 1 (Original)**: Olsen discloses an apparatus for determining the award of a plurality of prizes having respective prize values, the apparatus including:

- memory for storing data indicative of a current prize value (Olsen, column 6, lines 44-59);
- an input device being responsive to input signals from a respective plurality of gaming terminals for providing an increment signal (Olsen, column 7, lines 15-38);
- a controller for defining the current prize value as a first of the prize values and being responsive to the increment signal for incrementing an accumulated value toward the current prize value (Olsen, column 6, lines 44-59); and
- a comparator being responsive to the current prize value and the accumulated value for determining if the current prize value is to be awarded and, if so, generating an award signal that actuates the controller to define the current prize value as a second of the prize values (Olsen, column 2, lines 43-51).

Regarding **Claim 2 (Original)**: Olsen further discloses wherein the prize values fall within a range between an upper prize value and a lower prize value (Olsen, column

2, line 52-column 3, line 6) and the memory also contains data indicative of the upper prize value and the lower prize value (Olsen, column 6, lines 44-59 and Figure 2).

Regarding **Claim 3 (Original)**: Olsen further discloses wherein the controller is responsive to the upper prize value and the lower prize value for determining the second of the prize values (Olsen, column 6, lines 44-59 and Figure 2).

Regarding **Claim 5 (Currently Amended)**: Olsen further discloses wherein upon determination that the current prize value is to be awarded, the accumulated value is reset to one or other of the upper prize value or the lower prize value (Olsen, column 2, line 52-column 3, line 6).

Regarding **Claim 7 (Currently Amended)**: Olsen further discloses wherein the terminals are respective gaming machines (Olsen, column 4, lines 51-59).

Regarding **Claim 8 (Currently Amended)**: Olsen further discloses wherein the terminals are computer devices such as stand alone desktop computers (Olsen, column 21, lines 4-15).

Regarding **Claim 9 (Currently Amended)**: Olsen further discloses wherein the terminals include gaming machines and computer devices (Olsen, column 21, lines 4-15).

Regarding **Claim 10 (Currently Amended)**: Olsen further discloses wherein the computer devices are linked to the apparatus via web-enabled or other online interfaces (Olsen, column 4, lines 51-59).

Regarding **Claim 11 (Currently Amended)**: Olsen further discloses a payout device that is responsive to the increment signal and the award signal for selecting the terminal to which the prize is awarded (Olsen, column 5, lines 16-25).

Regarding **Claim 12 (Original)**: Olsen further discloses wherein each terminal includes a gaming balance and the payout device, upon selecting the terminal, credits the respective gaming balance (Olsen, column 17, lines 43-57).

Regarding **Claim 13 (Original)**: Olsen further discloses wherein the payout device credits the gaming balance by the accumulated value (Olsen, column 17, lines 43-57).

Regarding **Claim 14 (Currently Amended)**: Olsen further discloses a display driver for providing persons using the terminals with a visual indication of the accumulated value (Olsen, column 1, line 52-column 2, line 2).

Regarding **Claim 15 (Currently Amended)**: Olsen further discloses wherein the terminals including gaming machines are located in an establishment, the display driver is a dedicated hardware and software device that drives an LED display that is prominently located within the establishment (Olsen, column 20, lines 16-35; column 20, line 63-column 21, line 3; and Figure 7).

Regarding **Claim 16 (Currently Amended)**: Olsen further discloses wherein the terminals include computer devices (Olsen, column 21, lines 4-15) and the display driver is coded into communications protocol between the apparatus and the computer devices (Olsen, column 20, lines 16-35).

Regarding **Claim 17 (Currently Amended)**: Olsen further discloses wherein the driver also provides persons using the terminals with a visual indication of one or more of:

- the upper prize value (Olsen, column 2, lines 43-51);
- the lower prize value (Olsen, column 2, line 52-column 3, line 6); and
- whether the accumulated value is incrementing toward the upper or the lower prize value.

Regarding **Claim 18 (Currently Amended)**: Olsen further discloses wherein the comparator is part of the controller (Olsen, column 2, lines 43-51).

Regarding **Claim 25 (Original)**: Olsen discloses

- storing data indicative of a current prize value (Olsen, column 6, lines 44-59);
- being responsive to input signals from a respective plurality of gaming terminals for providing an increment signal (Olsen, column 6, lines 44-59);
- providing a controller for defining the current prize value as a first of the prize values and being responsive to the increment signal for incrementing an accumulated value toward the current prize value (Olsen, column 6, lines 44-59); and
- being responsive to the current prize value and the accumulated value for determining if the current prize value is to be awarded (Olsen, column 6, lines 44-59) and, if so, generating an award signal that actuates the controller to define the current prize value as a second of the prize values (Olsen, column 2, lines 43-51).

Regarding **Claim 28 (New)**: Olsen discloses a method of awarding a plurality of prizes having respective prize values, comprising:

- (a) monitoring wagers from multiple terminals (Olsen, column 1, line 52-column 2, line 2);
- (b) setting a current prize value to a first prize value (Olsen, column 7, lines 15-38);

(c) incrementing an accumulated value in accordance with the wagers until the accumulated value is equal to or beyond a threshold (Olsen, column 7, lines 15-38);

(d) identifying the terminal whose wager resulted in the accumulated value being equal to or beyond the threshold (Olsen, column 7, lines 50-54);

(e) setting the current prize value to a second prize value (Olsen, column 8, lines 25-43); and

(f) repeating steps (c) and (d) (Olsen, column 1, lines 29-51).

Regarding **Claim 29 (New)**: Olsen further discloses wherein the threshold is equal to the current prize value (Olsen, column 7, lines 50-54).

Regarding **Claim 30 (New)**: Olsen further discloses wherein the threshold is equal to the current prize value (Olsen, column 7, lines 50-54 and Figure 2) and step (c) comprises incrementing the accumulated value until the accumulated value is equal to the current prize value (Olsen, column 18, line 59-column 19, line 2).

Regarding **Claim 31 (New)**: Olsen further discloses wherein the threshold is equal to the current prize value (Olsen, column 7, lines 50-54 and Figure 2) and step (c) comprises incrementing the accumulated value until the accumulated value is beyond the current prize value (Olsen, column 18, line 59-column 19, line 2).

Regarding **Claim 32 (New)**: Olsen further discloses an upper prize value and a lower prize value, wherein steps (b) and (e) comprise setting the current prize value between the upper prize value and the lower prize value (Olsen, column 2, lines 3-22).

Regarding **Claim 34 (New)**: Olsen further discloses displaying the accumulated value (Olsen, column 1, line 52-column 2, line 2), the upper prize value (Olsen, column 2, lines 43-51), and the lower prize value (Olsen, column 2, line 52-column 3, line 6).

Regarding **Claim 38 (New)**: Olsen further discloses awarding the first and second prize values to players associated with the identified terminals (Olsen, column 2, lines 43-51).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 4, 6, 33, and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen in view of Marks et al., US 2003/0236116 A1 (hereinafter Marks).

Regarding **Claim 4 (Currently Amended)**: Olsen discloses the invention as disclosed above. Olsen fails to clearly disclose wherein a prize value is determined to fall alternately between:

- the current prize value and the upper prize value; and
- the current prior prize value and the lower prize value.

Marks teaches wherein the prize value may be increased or decreased base on any other acceptable method (Marks, ¶86).

Players get bored with the games that are put forward as new that offer different graphics, while keeping the rest of the game the same (Marks, ¶15). Marks teaches a progressive award in which the progressive award value may increase with each spin of the underlying game (Marks, ¶82) or wherein the progressive award may increase or decrease based on any other acceptable method (Marks, ¶86). Changing the way awards are determined and displayed provides players with new and enjoyable gaming experiences. Although Marks fails to clearly indicate that the award must alternate between the current prize level and the upper prize value and the lower prize value, prizes that oscillate from towards a maximum and then reverse towards the minimum are well known in the art and provide one of many sources of varying progressive awards.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the progressive jackpot game as disclosed by Olsen with the method of increasing or decreasing the progressive award as taught by Marks in order to offer players a new and exciting game.

Regarding **Claim 6 (Original)**: Marks further teaches wherein the accumulated value is alternately reset to the upper prize value and the lower prize value (Marks, ¶86).

Regarding **Claim 33 (New)**: Marks teaches wherein step (b) comprises setting the current prize value between the accumulated value and the upper prize value (Marks, ¶86), and step (e) comprises setting the current prize value between the accumulated value and the lower prize value (Marks, ¶86).

Regarding **Claim 35 (New)**: Marks teaches wherein step (b) comprises setting the accumulated value to the upper prize value (Marks, ¶86), and step (e) comprises setting the accumulated value to the lower prize value (Marks, ¶86).

Regarding **Claim 37 (New)**: Marks teaches wherein step (c) comprises weighting the wagers (Marks, ¶30).

10. **Claim 36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen in view of Nakatsu, US 2005/0079911 A1 (hereinafter Nakatsu).

Regarding **Claim 36 (New)**: Olsen further discloses wherein step (a) comprises monitoring wagers from the multiple terminals (Olsen, column 1, line 52-column 2, line 2).

Olsen fails to clearly disclose wherein each of the multiple terminals are executing games that are otherwise independent of one another.

Nakatsu teaches wherein each of the multiple terminals is executing games that are otherwise independent of one another (Nakatsu, ¶¶46 and ¶149).

Progressive jackpots are well known to one of ordinary skill in the art. Many times, the progressive jackpot is won once the accumulated jackpot pool reaches a specific amount and is independent of the outcome of a primary game. Nakatsu teaches a jackpot game in which players may participate without having to receive a specific outcome in a primary game (Nakatsu, ¶¶46 and ¶149).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the progressive jackpot game as disclosed by Olsen with the progressive game taught by Nakatsu in order to encourage players to play gaming devices with the possibility of winning a jackpot.

Prior art made of record

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rothkranz et al., US 2004/0053670 A1 (hereinafter Rothkranz) describes a gaming device with movable symbol indicators that oscillate back and forth, varying an award over time (Rothkranz, ¶¶42).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WERNER GARNER whose telephone number is (571) 270-7147. The examiner can normally be reached on M-F 7:30-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/WERNER GARNER/
Examiner, Art Unit 3714